

## REMARKS

### Summary of Action

In the subject office action, the Examiner rejected

(a) claims 1, 4-12, 15-18, 20, 21, 24-32, 35-38 and 40 under 35 USC 103 as being unpatentable over Ukita and Namias combined;

(b) claims 2-3, 13-14, 22-23 and 33-34 under USC 103 as being unpatentable over Ukita, Namias and Heiden combined; and

(c) claims 19 and 39 under USC 103 as being unpatentable over Ukita, Namias and Krishan combined.

### Rejection of claims 1, 4-12, 15-18, 20, 21, 24-32, 35-38 and 40

In response, Applicant has amended claims 1, 4, 8-12, 16, 18, 20-21, 25-26, 29, 31-32 and 36. With the exception of claims 1 and 21, where the claims were amended to overcome the prior art, none of the other amendments are entered to overcome the prior art. The other amendments are merely entered to either improve the readability of the claims or to correct previously undetected informalities. All amendments are supported by the original disclosure. No new matters have been introduced.

Claims 1 and 21 have been amended to conform to claims 12 and 32, such that they all clearly require that

- the advertisements (or the links thereto) are inserted into a message being sent to a number of recipients for the sender,
- the indication to insert is received from/provided by the sender, and

- the monetary cost being reduced by the monetary value of the insertion is the sending cost to the sender.

In contrast Utika's teaching is merely limited reducing the communication cost to a user subscriber of a communication service, if the user subscriber allows content/email/fax messages to be sent to the user with advertisements (inserted by the service provider). In Utika's case, the cost is the communication cost to the user subscriber, not the cost to the content provider for providing the "messages" to the user subscriber. The indication to allow insertion of advertisement is controlled by the user subscriber, who is not the sender of the "messages". There is no teaching in Utika that suggests advertisement be selectively inserted into a message sent by the user/subscriber to other recipients, at the control/option of the user/subscriber, to reduce the communication cost of the user/subscriber.

Accordingly, even if the Examiner's reading of Namias' teaching is correct, the combination nonetheless failed to suggest the claimed method/apparatus of claims 1, 12, 21, and 32 having the enumerated limitations. Therefore, claims 1, 12, 21 and 32 are patentable over Utika and Namias combined.

Claims 4-11, 15-18, 20, 24-31, 35-38 and 40 are dependent on claims 1, 12, 21 and 32, incorporating their limitations respectively. Therefore, for at least the same reasons, claims 4-11, 15-18, 20, 24-31, 35-38 and 40 are patentable over Utita and Namias combined.

#### Rejection of claims 2-3, 13-14, 22-23 and 33-34

Claims 2-3, 13-14, 22-23 and 33-34 are dependent on claims 1, 12, 21 and 32, incorporating their limitations respectively. Therefore, for at least the same reasons, claims 2-3, 13-14, 22-23 and 33-34 are patentable over Ukita and Namias

combined. Heiden does not remedy the above discussed deficiencies of Ukita, Namias. Therefore, for at least the same reasons, claims 2-3, 13-14, 22-23 and 33-34 are patentable over Ukita and Namias, even when combined with Heiden.

Rejection of claims 19 and 39

Claims 19 and 39 are dependent on claims 12 and 32, incorporating their limitations respectively. Therefore, for at least the same reasons, claims 19 and 39 are patentable over Ukita and Namias combined. Krishan does not remedy the above discussed deficiencies of Ukita, Namias. Therefore, for at least the same reasons, claims 2-3, 13-14, 22-23 and 33-34 are patentable over Ukita and Namias, even when combined with Krishan.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-40 are all in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
Applicants

Date: October 18, 2004

  
by, Aloysius AuYeung, Reg. No. 35,432  
Schwabe, Williamson & Wyatt, P.C.  
Attorney for Applicants

Pacwest Center  
1211 SW Fifth Ave., Ste 1600-1900  
Portland, Oregon 97204  
Phone: (503) 222-9981, FAX: (503) 796-2900